

TTAB

SMITH&RENDON<sup>LLP</sup>  
ATTORNEYS AT LAW

2222 Martin  
Suite 255  
Irvine, California 92612-1481  
Tel. (949) 474-2231  
Fax (949) 260-0940



www.smithrendon.com

December 12, 2006

333 South Grand Avenue  
Suite 4200  
Los Angeles, California 90071-1546  
Tel. (213) 626-9000  
Fax (213) 626-2870

Reply To:

Los Angeles

**VIA U.S. MAIL – FIRST CLASS**

Trademark Trial and Appeal Board  
U.S. Patent and Trademark Office  
P.O. Box 1451  
Alexandria, VA 22313-1451

**Re: Motion for Leave to File Amended Answer and Counterclaim to Petition for Cancellation & Amended Answer**

Mark: TITAN  
Registered: October 18, 2005  
Cancellation No.: 92045935  
Registrant: NISSAN JIDOSHA KABUSHIKI KAISHA  
also trading as NISSAN MOTOR CO., LTD.  
Petitioner: TITAN INTERNATIONAL, INC.

Dear Sir:

Enclosed please find the following:

1. Registrant's Motion for Leave to File Amended Answer and Counterclaim to Petition for Cancellation; and
2. Registrant's Amended Answer to Petition for Cancellation, And Counterclaim for Cancellation.

Please note that these documents were originally filed on December 11, 2006. The December 11 filing, however, was mailed to the USPTO general address without reference to the TTAB. In order to expedite the TTAB's receipt of the documents we are re-filing the documents by sending them directly to the TTAB address noted above.

12-14-2006

U.S. Patent & TMO/c/TM Mail Rcpt Dt. #22

TTAB  
December 12, 2006  
Page 2

Please charge Deposit Account No. 50-0594 to cover the requisite filing fee. If you have any questions regarding this application, please contact us at (213) 626-9000.

Very truly yours,

A handwritten signature in black ink, appearing to read "Martin Kosla". The signature is fluid and cursive, with the first name "Martin" and last name "Kosla" clearly distinguishable.

MARTIN KOSLA

Encl.

cc: Daniel A. Rosenberg

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

TITAN INTERNATIONAL, INC.,	)	
	)	
Petitioner,	)	
	)	Cancellation No. 92045935
v.	)	
	)	
NISSAN JIDOSHA KABUSHIKI	)	
KAISHA T/A	)	
NISSAN MOTOR CO., LTD.,	)	
	)	
Registrant.	)	

**REGISTRANT'S MOTION FOR LEAVE TO FILE AMENDED ANSWER AND  
COUNTERCLAIM TO PETITION FOR CANCELLATION**

Registrant, Nissan Jidosha Kabushiki Kaisha t/a Nissan Motor Co., Ltd., hereby moves the Board for an order permitting it to file an Amended Answer to the Petition for Cancellation pursuant to Rule 15(a) Fed. R. Civ. P., 37 C.F.R. 2.107, TBMP 507.02 to plead Laches as an Affirmative Defense and to Counterclaim for Cancellation of Petitioner's Registration No. 2933421.

Subsequent to Registrant's filing of its Original Answer, Registrant learned of facts indicating that Petitioner knew or should have known of Registrant's registration and use of the mark for which Petitioner seeks cancellation. Similarly, on November 25, 2006, Registrant first learned that the USPTO appears to have issued one of Petitioner's pleaded registrations with an incorrect and materially overbroad identification of goods. Specifically, whereas on March 27, 1997, Petitioner filed an amendment to its application Serial No. 75/097303 to narrow the goods to "land vehicle parts and components, namely, trailer brakes and brake actuators," the USPTO issued a registration for the following description of goods, "land vehicle parts and components, namely, wheels, rims, tires, brakes and actuators for on-the-road vehicles." If this identification

is not corrected, Registrant will be required to defend the issue of likelihood of confusion based on a materially broader identification and statutory presumptions that are incorrect.

In support of its motion, Registrant notes that the grounds for the Affirmative Defense and the Counterclaim set forth in the proposed Amended Answer of Registrant are based on information Registrant just recently learned.

Pursuant to the Federal Rule of Civil Procedure 15, "leave to amend shall be freely given when justice so requires." The Board has granted leave to amend pleadings with considerable liberality where the amendment does not violate settled law and the circumstances are such that the adverse party is not prejudiced.

Registrant submits that permitting it to amend its Answer will not prejudice Petitioner and that this motion is timely insofar as the Affirmative Defense and the Counterclaim is based on information just recently learned, after the Answer of Cancellation was filed. Further, this case still is in the pretrial stage.

Since the Board proceeding still is in an early pre-trial state, leave to amend should be allowed. See e.g. *Space Base Inc v Stadis Corp*, 17 USPQ2d 1216 n.1 (TTAB 1991). By allowing Registrant to amend its Answer, the Board is permitting full adjudication of the merits in this dispute. The fact that the adverse party may be prejudiced as a result of the delay in the proceeding is generally outweighed by the principle that there should be full adjudication.

Registrant attaches hereto a copy of the proposed amended pleading pursuant to TBMP Section 507.01.

Wherefore, Registrant respectfully requests that this Board grant this Motion for Leave to File the attached Amended Answer and Counterclaim for Cancellation.

Dated: December 11, 2006

Respectfully submitted,

By:

A handwritten signature in cursive script, appearing to read "Rhea Caras", is written over a horizontal line.

Rhea Caras  
Smith & Rendon, I.L.P.  
333 South Grand Avenue, Suite 4200  
Los Angeles, CA 90071-1546  
Telephone: 213-626-9000  
Facsimile: 213-626-2870  
Attorneys for Registrant



4. Registrant is without knowledge or information sufficient to form a belief as to the truth of the allegations set forth in Numbered Paragraph 4 of the Petition for Cancellation, and therefore, denies the same.

5. Registrant is without knowledge or information sufficient to form a belief as to the truth of the allegations set forth in Numbered Paragraph 5 of the Petition for Cancellation, and therefore, denies the same.

6. Registrant denies the allegations set forth in Numbered Paragraph 6 of the Petition for Cancellation.

7. Registrant is without knowledge or information sufficient to form a belief as to the truth of the allegations set forth in Numbered Paragraph 7 of the Petition for Cancellation, and therefore, denies the same.

8. Registrant is without knowledge or information sufficient to form a belief as to the truth of the allegations set forth in Numbered Paragraph 8 of the Petition for Cancellation, and therefore, denies the same.

9. Registrant is without knowledge or information sufficient to form a belief as to the truth of the allegations set forth in Numbered Paragraph 9 of the Petition for Cancellation, and therefore, denies the same.

10. Registrant admits the allegations set forth in Numbered Paragraph 10 of the Petition for Cancellation.

11. Registrant is without knowledge or information sufficient to form a belief as to the truth of the allegations set forth in Numbered Paragraph 11 of the Petition for Cancellation, and therefore, denies the same.

12. Registrant denies the allegations set forth in Numbered Paragraph 12 of the Petition for Cancellation.

13. Registrant denies the allegations set forth in Numbered Paragraph 13 of the Petition for Cancellation.

#### **AFFIRMATIVE DEFENSES**

1. Petitioner's claim is barred by the doctrine of laches in that upon information and belief Petitioner knew or should have known of Registrant's application which subsequently resulted in the registration of the mark for which Registrant seeks cancellation as well as Registrant's use of such mark and Petitioner failed to take any action against such application and use and registration which Registrant relied on to its detriment.

#### **COUNTERCLAIM FOR CANCELLATION OR RESTRICTION**

1. By certificate of mailing dated March 27, 1997, Petitioner filed an amendment to its application Serial No. 75/097303 to limit the goods to "land vehicle parts and components, namely, trailer brakes and brake actuators."

2. Despite this amendment, The United States Patent and Trademark Office subsequently issued a Notice of Allowance and Certificate of Registration for Registration No. 2,933,421 with the following description of goods, "land vehicle parts and components, namely, wheels, rims, tires, brakes and actuators for on-the-road vehicles."

3. The issuance by the United States Patent and Trademark Office of Registration No. 2,933,421 with the following description of goods, "land vehicle parts and components, namely, wheels, rims, tires, brakes and actuators for on-the-road vehicles" was incorrect.



4. The following description of goods, "land vehicle parts and components, namely, wheels, rims, tires, brakes and actuators for on-the-road vehicles" is materially broader than the identification of goods listed in Petitioner's March 27, 1997 amendment.

5. Upon information and belief, Petitioner knew or should have known that the Notice of Allowance and subsequently issued Certificate of Registration were materially incorrect. Nonetheless, Petitioner filed a Statement of Use and subsequent communications with United States Patent and Trademark Office knowingly failing to disclose the material defect in the Notice of Allowance and Statement of Use, upon which the Office relied to its detriment in issuing an invalid and incorrect Certificate of Registration. But for Petitioner's knowingly incorrect Statement of Use and subsequent communications, the Office would not have issued a Certificate of Registration in connection with the broader description of goods. Petitioner is therefore guilty of fraud.

6. As it is entitled to the statutory assumption of Section 7 of the Lanham Act, Registration No. 2,933,421's present description of goods damages Registrant/Counterclaim Petitioner. It requires Registrant/Counterclaim Petitioner to defend the issue of likelihood of confusion based on the materially broader description of goods in Registration No. 2,933,421, rather than the description of goods in Petitioner's March 27, 1997 amendment.

7. The continued maintenance of Registration No. 2,933,421 with the following description of goods, "land vehicle parts and components, namely, wheels, rims, tires, brakes and actuators for on-the-road vehicles," damages Registrant/Counterclaim Petitioner and is inconsistent with Section 18 of the Lanham Act.

**WHEREFORE**, REGISTRANT prays that the Petition for Cancellation be dismissed with prejudice and that the Board amend the description of goods in Registration Number

2,933, 421 to "land vehicle parts and components, namely, trailer brakes and brake actuators" or that Registration No. 2,933,421 be cancelled in its entirety.

Respectfully submitted,

NISSAN JIDOSHA KABUSHIKI KAISHA TA  
NISSAN MOTOR CO., LTD.

BY:



Rhea Caras

Attorney for Registrant

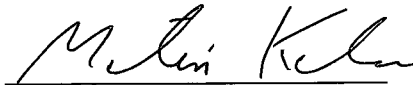
SMITH & RENDON, LLP  
333 South Grand Avenue  
Suite 4200  
Los Angeles, CA 90071-1546  
Telephone: (213) 626-9000  
Facsimile: (213) 626-2870

Dated: December 11, 2006

**CERTIFICATE OF SERVICE**

I hereby certify that a true and complete copy of the foregoing REGISTRANT'S MOTION FOR LEAVE TO FILE AMENDED ANSWER AND COUNTERCLAIM TO PETITION FOR CANCELLATION has been served on Daniel A. Rosenberg by mailing said copy on December 12, 2006, via First Class Mail, postage prepaid to:

Daniel A. Rosenberg  
Davis, Brown, Koehn, Shors & Roberts, P.C.  
The Financial Center  
666 Walnut Street, Suite 2500  
Des Moines, Iowa 50309

A handwritten signature in cursive script, appearing to read "Martin Kosla", written over a horizontal line.

Martin Kosla

**CERTIFICATE OF MAILING UNDER 37 CFR 1.8(a)**

Mark: TITAN  
Registered: October 18, 2005  
Cancellation No.: 92045935  
Registrant: NISSAN JIDOSHA KABUSHIKI KAISHA, also trading as  
NISSAN MOTOR CO., LTD.  
Petitioner: TITAN INTERNATIONAL, INC.

Re: Registrant's Motion for Leave to File Amended Answer and Counterclaim to  
Petition for Cancellation

I hereby certify that the above-identified document, which is attached, is being deposited  
with the United States Postal Service with sufficient postage as first class mail in an  
envelope addressed to:

Trademark Trial and Appeal Board, U.S. Patent and Trademark Office, P.O. Box 1451  
Alexandria, VA 22313-1451, on December 12, 2006.



---

Martin Kosla

December 12, 2006

Date

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

Mark: TITAN

Registered: October 18, 2005

TITAN INTERNATIONAL, INC.,	)	
Petitioner,	)	
	)	
v.	)	
	)	Cancellation No. 92045935
NISSAN JIDOSHA KABUSHIKI KAISHA	)	
TA NISSAN MOTOR CO., LTD.,	)	
Registrant.	)	
	)	

**REGISTRANT'S AMENDED ANSWER TO PETITION FOR CANCELLATION, AND  
COUNTERCLAIM FOR CANCELLATION**

NISSAN JIDOSHA KABUSHIKI KAISHA TA NISSAN MOTOR CO., LTD.,  
Registrant in the above-identified cancellation proceeding, hereby answers the Petition for  
Cancellation filed by TITAN INTERNATIONAL, INC., as follows:

1. Registrant is without knowledge or information sufficient to form a belief as to  
the truth of the allegations set forth in Numbered Paragraph 1 of the Petition for Cancellation,  
and therefore, denies the same.

2. Registrant is without knowledge or information sufficient to form a belief as to  
the truth of the allegations set forth in Numbered Paragraph 2 of the Petition for Cancellation,  
and therefore, denies the same.

3. Registrant is without knowledge or information sufficient to form a belief as to  
the truth of the allegations set forth in Numbered Paragraph 3 of the Petition for Cancellation,  
and therefore, denies the same.

4. Registrant is without knowledge or information sufficient to form a belief as to the truth of the allegations set forth in Numbered Paragraph 4 of the Petition for Cancellation, and therefore, denies the same.

5. Registrant is without knowledge or information sufficient to form a belief as to the truth of the allegations set forth in Numbered Paragraph 5 of the Petition for Cancellation, and therefore, denies the same.

6. Registrant denies the allegations set forth in Numbered Paragraph 6 of the Petition for Cancellation.

7. Registrant is without knowledge or information sufficient to form a belief as to the truth of the allegations set forth in Numbered Paragraph 7 of the Petition for Cancellation, and therefore, denies the same.

8. Registrant is without knowledge or information sufficient to form a belief as to the truth of the allegations set forth in Numbered Paragraph 8 of the Petition for Cancellation, and therefore, denies the same.

9. Registrant is without knowledge or information sufficient to form a belief as to the truth of the allegations set forth in Numbered Paragraph 9 of the Petition for Cancellation, and therefore, denies the same.

10. Registrant admits the allegations set forth in Numbered Paragraph 10 of the Petition for Cancellation.

11. Registrant is without knowledge or information sufficient to form a belief as to the truth of the allegations set forth in Numbered Paragraph 11 of the Petition for Cancellation, and therefore, denies the same.

12. Registrant denies the allegations set forth in Numbered Paragraph 12 of the Petition for Cancellation.

13. Registrant denies the allegations set forth in Numbered Paragraph 13 of the Petition for Cancellation.

#### **AFFIRMATIVE DEFENSES**

1. Petitioner's claim is barred by the doctrine of laches in that upon information and belief Petitioner knew or should have known of Registrant's application which subsequently resulted in the registration of the mark for which Registrant seeks cancellation as well as Registrant's use of such mark and Petitioner failed to take any action against such application and use and registration which Registrant relied on to its detriment.

#### **COUNTERCLAIM FOR CANCELLATION OR RESTRICTION**

1. By certificate of mailing dated March 27, 1997, Petitioner filed an amendment to its application Serial No. 75/097303 to limit the goods to "land vehicle parts and components, namely, trailer brakes and brake actuators."

2. Despite this amendment, The United States Patent and Trademark Office subsequently issued a Notice of Allowance and Certificate of Registration for Registration No. 2,933,421 with the following description of goods, "land vehicle parts and components, namely, wheels, rims, tires, brakes and actuators for on-the-road vehicles."

3. The issuance by the United States Patent and Trademark Office of Registration No. 2,933,421 with the following description of goods, "land vehicle parts and components, namely, wheels, rims, tires, brakes and actuators for on-the-road vehicles" was incorrect.

4. The following description of goods, "land vehicle parts and components, namely, wheels, rims, tires, brakes and actuators for on-the-road vehicles" is materially broader than the identification of goods listed in Petitioner's March 27, 1997 amendment.

5. Upon information and belief, Petitioner knew or should have known that the Notice of Allowance and subsequently issued Certificate of Registration were materially incorrect. Nonetheless, Petitioner filed a Statement of Use and subsequent communications with United States Patent and Trademark Office knowingly failing to disclose the material defect in the Notice of Allowance and Statement of Use, upon which the Office relied to its detriment in issuing an invalid and incorrect Certificate of Registration. But for Petitioner's knowingly incorrect Statement of Use and subsequent communications, the Office would not have issued a Certificate of Registration in connection with the broader description of goods. Petitioner is therefore guilty of fraud.

6. As it is entitled to the statutory assumption of Section 7 of the Lanham Act, Registration No. 2,933,421's present description of goods damages Registrant/Counterclaim Petitioner. It requires Registrant/Counterclaim Petitioner to defend the issue of likelihood of confusion based on the materially broader description of goods in Registration No. 2,933,421, rather than the description of goods in Petitioner's March 27, 1997 amendment.

7. The continued maintenance of Registration No. 2,933,421 with the following description of goods, "land vehicle parts and components, namely, wheels, rims, tires, brakes and actuators for on-the-road vehicles," damages Registrant/Counterclaim Petitioner and is inconsistent with Section 18 of the Lanham Act.

**WHEREFORE**, REGISTRANT prays that the Petition for Cancellation be dismissed with prejudice and that the Board amend the description of goods in Registration Number



2,933, 421 to "land vehicle parts and components, namely, trailer brakes and brake actuators" or that Registration No. 2,933,421 be cancelled in its entirety.

Respectfully submitted,

NISSAN JIDOSHA KABUSHIKI KAISHA TA  
NISSAN MOTOR CO., LTD.

BY:

A handwritten signature in cursive script, appearing to read "Rhea Caras", written over a horizontal line.

Rhea Caras

Attorney for Registrant

SMITH & RENDON, LLP  
333 South Grand Avenue  
Suite 4200  
Los Angeles, CA 90071-1546  
Telephone: (213) 626-9000  
Facsimile: (213) 626-2870

Dated: December 11, 2006

**CERTIFICATE OF SERVICE**

I hereby certify that a true and complete copy of the foregoing REGISTRANT'S AMENDED ANSWER TO PETITION FOR CANCELLATION, AND COUNTERCLAIM FOR CANCELLATION has been served on Daniel A. Rosenberg by mailing said copy on December 12, 2006, via First Class Mail, postage prepaid to:

Daniel A. Rosenberg  
Davis, Brown, Koehn, Shors & Roberts, P.C.  
The Financial Center  
666 Walnut Street, Suite 2500  
Des Moines, Iowa 50309

  
\_\_\_\_\_  
Martin Kosla

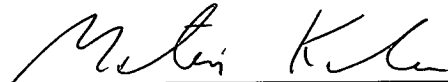
**CERTIFICATE OF MAILING UNDER 37 CFR 1.8(a)**

Mark: TITAN  
Registered: October 18, 2005  
Cancellation No.: 92045935  
Registrant: NISSAN JIDOSHA KABUSHIKI KAISHA, also trading as  
NISSAN MOTOR CO., LTD.  
Petitioner: TITAN INTERNATIONAL, INC.

Re: Registrant's Amended Answer to Petition for Cancellation, and Counterclaim for  
Cancellation

I hereby certify that the above-identified document, which is attached, is being deposited  
with the United States Postal Service with sufficient postage as first class mail in an  
envelope addressed to:

Trademark Trial and Appeal Board, U.S. Patent and Trademark Office, P.O. Box 1451  
Alexandria, VA 22313-1451, on December 12, 2006.



---

Martin Kosla

December 12, 2006

---

Date